



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0489

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Gérard LANG et al.) Group Art Unit: 1751
Application No.: 09/424,116) Examiner: M. Einsmann
Filed: January 6, 2000)
For: OXIDATION DYEING COMPOSITION)
FOR KERATINOUS FIBRES)
CONTAINING A 3-AMINOPYRIDINE AZO)
DERIVATIVE AND DYEING METHOD)
USING SAID COMPOSITION)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO EXAMINER'S COMMUNICATION

In a Communication dated October 27, 2003, the Examiner noted that Appellants had mentioned a new reference on page 24 of their Second Appeal Brief, which was filed on August 26, 2003. The Examiner is correct that U.S. Patent No. 3,933,886 to Saygin was referenced in footnote 8 of the Second Appeal Brief to demonstrate that it is known that direct dyes can, in addition to functioning as direct dyes, participate in oxidation dye formation as, for example, coupling agents.

According to the Examiner, (1) "[i]f [the reference to U.S. Patent No. 3,933,886 to Saygin] were permitted, it must be cited on an Information Disclosure" and (2) "it is considered new evidence in an application on appeal which is not a matter of right."

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(October 27, 2003, Communication.) For at least the following reasons, Appellants respectfully request that the Examiner consider the Second Appeal Brief, as filed on August 26, 2003, in its entirety, including its reference to 3,933,866 to Saygin. However, in order to be fully response to the Examiner's Communication, a Revised Second Appeal Brief, which does not reference U.S. Patent No. 3,933,886 to Saygin, is being filed herewith and within the one month time period set in the Examiner's Communication.

A. U.S. PATENT NO. 3,933,886 TO SAYGIN

U.S. Patent No. 3,933,886 to Saygin, was referenced in the Second Appeal Brief in response to the Examiner's argument that, apparently to the best of her knowledge, oxidation dyes and direct dyes do not interact. (See, e.g., Office Action dated February 12, 2003, pg. 6-7.) Specifically, U.S. Patent No. 3,933,886 to Saygin was referenced to demonstrate that it is known in the art that direct dyes can, in addition to functioning as direct dyes, participate in oxidation dye formation as, for example, coupling agents. For instance, according to Saygin, "[i]t is an object of the present invention to provide an aqueous hair dye preparation containing a diamino-nitro-benzene compound which acts as a direct dye or which acts as a coupling component along with a developer component in an oxidation dyestuff composition." (U.S. Patent No. 3,933,886 to Saygin, col. 1, ln. 21-26.) Thus, as demonstrated by Saygin, direct dyes can interact with oxidation dyes.

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B. REQUIREMENT FOR AN INFORMATION DISCLOSURE STATEMENT DO NOT PROHIBIT APPELLANTS' REFERENCE TO U.S. PATENT NO. 3,933,886 TO SAYGIN

Appellants do not agree that U.S. Patent No. 3,933,886 to Saygin must be provided in an Information Disclosure Statement. As explained in the MPEP,

It should be noted that the rules [37 CFR § 1.56] are not intended to require information favorable to patentability such as, for example, evidence of commercial success of the invention. Similarly, the rules are not intended to require, for example, disclosure of information concerning the level of skill in the art for purposes of determining obviousness.

MPEP § 2001.04 (emphasis added). Thus, since U.S. Patent No. 3,933,886 to Saygin is referenced to demonstrate that direct dyes can chemically react with oxidation dye components, which relates to the knowledge of one skilled in the art, its disclosure under 37 CFR § 1.56 would not have been required, and its citation in an Information Disclosure Statement should not be required.

Accordingly, the Examiner's requirement for an Information Disclosure Statement is not correct. To the extent the Examiner had relied on this incorrect requirement, Appellants respectfully request that the Examiner withdraw the objection and fully consider the Second Appeal Brief, as filed on August 26, 2003, in its entirety, including its reference to U.S. Patent No. 3,933,886 to Saygin to demonstrate the inaccuracy of the Examiner's argument that oxidation dyes and direct dyes do not interact.

C. "NEW EVIDENCE" AND THE EXAMINER'S DISCRETION DO NOT, OR SHOULD NOT, PROHIBIT APPELLANTS' REFERENCE TO U.S. PATENT NO. 3,933,886 TO SAYGIN

Appellants recognize that according to MPEP § 1207, "[e]ntry of a new amendment, new affidavit, or other new evidence in an application on appeal is not a matter of right." However, Appellants submit that this limitation is not of issue under the

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present facts, and, to the extent that it is, respectfully request that the Examiner exercise her discretion to consider the Second Appeal Brief in its entirety as filed on August 26, 2003, including its reference to U.S. Patent No. 3,933,866 to Saygin to demonstrate that direct dyes are known to interact with oxidation dye components.

In the context of the above-quoted portion of MPEP § 1207, the section further states that “[t]he entry of an amendment (which may or may not include a new affidavit, declaration, or exhibit) submitted in an application on appeal continues to be governed by 37 CFR 1.116.” (*Id.*) However, this is not relevant to the present issue since entry of a new amendment has not been requested. Thus, this provision is not a basis to refuse consideration of the Second Appeal Brief as filed on August 26, 2003, including its reference to U.S. Patent No. 3,933,866 to Saygin to demonstrate that direct dyes are known to interact with oxidation dye components.

MPEP § 1207 also states that “the entry of a new affidavit or other new evidence in an application on appeal is governed by 37 CFR 1.195.” However, this too is not relevant, since 37 CFR § 1.195 only refers to “Affidavits, declarations, or exhibits,” none of which are at issue with respect to U.S. Patent No. 3,933,866 to Saygin. Thus, this too is not a basis to refuse consideration of the Second Appeal Brief in its entirety as filed on August 26, 2003, including its reference to U.S. Patent No. 3,933,866 to Saygin to demonstrate that direct dyes are known to interact with oxidation dye components.

Nevertheless, to the extent that the reference to U.S. Patent No. 3,933,866 to Saygin to demonstrate that direct dyes are known to interact with oxidation dye components is considered “new evidence” within the meaning of MPEP § 1207, Appellants respectfully request that the Examiner use her discretion to consider the

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Second Appeal Brief in its entirety as filed on August 26, 2003, including its reference to U.S. Patent No. 3,933,866 to Saygin.

Consideration of the originally filed Second Appeal Brief is appropriate given that the Examiner mistakenly argued in the last Office Action that oxidation dyes and direct dyes do not interact. (Office Action dated February 12, 2003, pg. 6-7.) It is also appropriate to consider the Second Appeal Brief in its entirety as filed on August 26, 2003, including its reference to U.S. Patent No. 3,933,866 to Saygin to demonstrate that direct dyes are known to interact with oxidation dye components, given the Examiner's incorrect technical understanding that "direct dyes do not react with the [oxidation] bases and coupler." (Office Action of July 31, 2002, pg. 7, ln. 1-5.)

U.S. Patent No. 3,933,866 to Saygin is, thus, clearly relevant to an obviousness inquiry via the determination of "the mind of one skilled in the art ... who is normally guided by the then-accepted wisdom in the art." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303,313 (Fed. Cir. 1983). Therefore, it is appropriate for the Examiner to exercise her discretion to consider the Second Appeal Brief in its entirety as filed on August 26, 2003, including its reference to U.S. Patent No. 3,933,866 to Saygin to demonstrate that direct dyes are known to interact with oxidation dye components, in order to, among other things, correct the Examiner's erroneous technical understanding that direct dyes and oxidation dye components cannot interact.

D. CONCLUSION

For the reasons stated herein, Appellants respectfully request that the Examiner reconsider the decision regarding considering the Second Appeal Brief, as filed on August 26, 2003, in its entirety.

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If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: November 13, 2003

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